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**JUL 26 2006**

**OFFICE OF PETITIONS**

In re Application	:
Anthony Nicholls	:
Application No. 09/644,937	: DECISION ON APPLICATION
Filed: August 23, 2000	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. 19455-002001	:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed February 1, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred ninety-four (194) days to five hundred eleven (511) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **one hundred ninety-five (195) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 4, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred ninety-four (194) days.

On December 5, 2005, Applicants timely<sup>1</sup> submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is five hundred eleven (511) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of one hundred ninety-four (194) days based on an adjustment for PTO delay of two hundred ten (210) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), one hundred eighty (180) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. 1.703(a)(2), and fifty-nine (59) days pursuant to 35 U.S.C. 154(b)(1)(A)(iv) and 37 C.F.R. 1.703(a)(2), reduced by applicant's delays of ninety-one (91) and thirty-two (32) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and one hundred thirty-two (132) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. 1.704(c)(7). The adjustments of 91, 132, and 59 days are at issue.

The adjustment of ninety-one (91) days has been found to be incorrect. A review of the record confirms that the corresponding amendment was filed via Express Mail on March 10, 2003, not March 11, 2003. Accordingly, applicant delay with respect to this filing should have been ninety (90) days.

With respect to the adjustment of one hundred thirty-two (132) days, the Office mailed an Office action on September 10, 2002. Applicants filed a reply on March 10, 2003. However, the reply was not proper, and the Office mailed a Notice of Non-Responsive Amendment on June 30, 2003. The Notice required a substitute abstract beginning on a separate paper, as required by 37 C.F.R. §1.72(b). Applicants filed a proper reply on July 21, 2003, and were assessed delay of one hundred thirty-two (132) days pursuant to 37 C.F.R. 1.704(c)(7). The Office has stated that:

Section 1.704(c)(7) establishes submission of a reply having an omission (1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

Submitting a reply having an omission requires the Office to issue an action under 1.135(c) and await and process the applicant's reply to the action under 1.135(c) before the initial reply (as corrected) can be treated on its merits.<sup>2</sup>

Lastly, Applicants assert that the fifty-nine (59) days of PTO delay for the delay in mailing a Notice of Allowance should instead total one hundred ten (110) days. The Office mailed a

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<sup>1</sup> Applicants filed the instant application for patent term adjustment together with the payment of the issue fee.

<sup>2</sup> Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14, 65 Fed. Reg. 54366 (Oct. 3 2000).

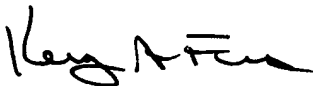
Notice of Allowance to the correct address of record on September 14, 2005, and were assessed PTO delay of fifty-nine (59) days. The Office mailed a corrected Notice of Allowance on November 1, 2005, restarting the period for reply for purposes of paying the issue fee. However, the Notice did not vacate the Notice of Allowance mailed September 14, 2005. Accordingly, the Office delay of fifty-nine (59) days was proper.

The correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **one hundred ninety-five (195) days** (449 (59+180+210) days of PTO delay, reduced by 254 (32+132+90) days of applicant delay).

The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 06-1050, as authorized.<sup>3</sup>

The application file is being forwarded to the Office of Patent Publication to complete the issuance process for the patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

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<sup>3</sup> See Comment 1 in Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14, 65 Fed. Reg. 54366 (Oct. 3 2000) (stating that the fee set forth in 37 C.F.R. 1.18(e) is charged to allow the Office to recover the estimated average cost of treating applications for patent term adjustment, and is not refundable even in the event of Office error).

Day : Tuesday  
Date: 7/25/2006 **PALM INTRANET**

Time: 11:11:53

**PTA Calculations for Application: 09/644937**

Application Filing Date:	08/23/2000	PTO Delay (PTO):	449
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	255
Post-Issue Petitions:	0	Total PTA (days):	195
PTO Delay Adjustment:	1		

**File Contents History**

Number	Date	Contents Description	PTO	APPL	START
77	07/25/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	1		
68	11/04/2005	MAIL CORRECTED NOTICE OF ALLOWANCE			
67	11/04/2005	MAIL EXAMINER'S AMENDMENT			
66	11/01/2005	ISSUE REVISION COMPLETED			
65	11/01/2005	CORRECTED NOTICE OF ALLOWANCE			
63	10/12/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
62	10/26/2005	EXAMINER'S AMENDMENT COMMUNICATION			
61	09/20/2005	EXPORT TO INITIAL DATA CAPTURE			
60	09/14/2005	MAIL NOTICE OF ALLOWANCE	59		49
59	09/14/2005	MAIL EXAMINER'S AMENDMENT			
58	09/08/2005	ISSUE REVISION COMPLETED			
57	09/08/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
56	09/08/2005	CASE DOCKETED TO EXAMINER IN GAU			
55	09/08/2005	EXAMINER'S AMENDMENT COMMUNICATION			
54	09/06/2005	NOTICE OF ALLOWABILITY			
53	08/16/2005	CORRESPONDENCE ADDRESS CHANGE			
52	08/03/2005	CASE DOCKETED TO EXAMINER IN GAU			
51	05/09/2005	CASE DOCKETED TO EXAMINER IN GAU			
50	03/31/2005	DATE FORWARDED TO EXAMINER			
49	03/17/2005	RESPONSE AFTER NON-FINAL ACTION			
48	12/17/2004	MAIL NON-FINAL REJECTION			
47	12/13/2004	NON-FINAL REJECTION			
46	09/28/2004	DATE FORWARDED TO EXAMINER			
45	09/20/2004	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			

44	09/28/2004	DATE FORWARDED TO EXAMINER			
43	09/20/2004	REQUEST FOR CONTINUED EXAMINATION (RCE)		32	35
42	09/28/2004	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
41	09/20/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
40	09/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
39	09/20/2004	WORKFLOW INCOMING AMENDMENT IFW			
38	09/20/2004	WORKFLOW - REQUEST FOR RCE - BEGIN			
37	08/25/2004	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
36	08/20/2004	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
35	05/19/2004	MAIL FINAL REJECTION (PTOL - 326)	180		28
34	05/17/2004	FINAL REJECTION			
33	04/22/2004	CORRESPONDENCE ADDRESS CHANGE			
32	04/23/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
31	03/11/2004	IFW AMENDED CASE PROCESSING COMPLETE			
29	03/03/2004	DATE FORWARDED TO EXAMINER			
28	07/21/2003	RESPONSE AFTER NON-FINAL ACTION		132	23
27	07/11/2003	MISCELLANEOUS INCOMING LETTER			
26	06/30/2003	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
25	03/11/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	03/20/2003	DATE FORWARDED TO EXAMINER			
23.1	03/11/2003	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
23	03/11/2003	RESPONSE AFTER NON-FINAL ACTION		91	21
22	03/11/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
21	09/10/2002	MAIL NON-FINAL REJECTION			
20	09/09/2002	NON-FINAL REJECTION			
19	08/28/2002	CASE DOCKETED TO EXAMINER IN GAU			
18	06/19/2002	X-PRE-LEGAL COMPLETE AMENDED CASE			
17	06/11/2002	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			

16	06/19/2002	DATE FORWARDED TO EXAMINER			
15	06/10/2002	RESPONSE TO ELECTION / RESTRICTION FILED			
14	05/21/2002	MAIL RESTRICTION REQUIREMENT	210		-1
13	05/20/2002	X-POST-LEGAL COMPLETE REJECTION			
12	05/20/2002	REQUIREMENT FOR RESTRICTION / ELECTION			
11	12/15/2001	CASE DOCKETED TO EXAMINER IN GAU			
10	10/29/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	10/29/2001	PRELIMINARY AMENDMENT			
8	11/27/2001	CASE DOCKETED TO EXAMINER IN GAU			
7	04/02/2001	CASE DOCKETED TO EXAMINER IN GAU			
6	03/07/2001	APPLICATION DISPATCHED FROM OIPE			
5	03/07/2001	APPLICATION IS NOW COMPLETE			
4	10/05/2000	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	10/05/2000	CORRESPONDENCE ADDRESS CHANGE			
2	09/11/2000	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/23/2000	INITIAL EXAM TEAM NN			

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#### **EXPLANATION OF PTA CALCULATION**

#### **EXPLANATION OF PTE CALCULATION**

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